

**REMARKS**

Claims 1-7 and 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hwang in view of AAPA. Solely in order to expedite issuance of the present application by reducing issues, independent claims 11 and 12 have been canceled without prejudice/disclaimer to the subject matter embodied thereby. Claims 1 and 6 are the sole remaining independent claims. This rejection is respectfully traversed for the following reasons.

The Examiner has apparently broadly construed the periphery region of the wafer as inclusive of internal regions such as disclosed in Hwang. In order to clarify the distinction between the present invention and Hwang, claim 1 has been amended to recite in pertinent part, “forming, in the buffer coat film, apertures including regions of the buffer coat film *extending from an edge of the wafer ...*” (emphasis added). One exemplary embodiment of the present invention recited in claim 1 is shown in Figure 1B, whereby the aperture 218 (extending from an edge of the wafer) enables the subsequent formation of a firm peripheral seal as shown in Figure 2, for example.

Similarly, claim 6 has been amended to recite in pertinent part, “reducing the thickness of *an outermost peripheral* part of the buffer coat film ...” (emphasis added). One exemplary embodiment of the present invention recited in claim 6 is shown in Figure 7B, whereby the reduced thickness part 208b of the buffer coat film at the outermost peripheral portion thereof enables the subsequent formation of a firm peripheral seal as shown in Figure 8, for example.

According to one aspect of the present invention, polishing slurry can be prevented from permeating inside the device during the rear surface polishing step (*see, e.g.*, page 3, line 14 – page 4, line 9 of Applicants’ specification). In contrast, the alleged aperture of Hwang is located

entirely on an internal portion of the wafer, and the alleged reduced thickness of Hwang is at best an entirely internal portion of the alleged buffer coat film.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the independent claims because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

### **CONCLUSION**

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If


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there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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